

### R E M A R K S

Reconsideration of this application, as amended, is respectfully requested.

### THE CLAIM AMENDMENTS

Claim 1 has been amended: to clarify that the heat generating portion is provided at a first grasp member of the pair of grasp members, and generates heat in accordance with current supplied thereto; to clarify that a cutting member is disposed at the first grasp portion in contact with the heat generating portion and projecting toward a second grasp member of the pair of grasp members, and is heated by the heat generating portion to cut the patient's body tissue grasped between the grasp members; and to clarify that the cutting member is shaped so as to be capable of cutting the patient's body tissue only when the heat generating portion is activated. Amended claim 1 is fully supported by the elected Species 42 (corresponding to the forty-second embodiment described in the specification and shown in Figs. 58-62).

Withdrawn claim 10 has been amended to better accord with amended independent claim 1, and withdrawn independent claims 21 and 23 have been amended to depend from claim 1.

Independent claim 49 has been amended: to clarify that the first engaging portion comprises a protrusion; to clarify that

the heating unit is provided in the first engaging portion in contact with the protrusion and heats the protrusion when energized; and to clarify that the first engaging surface is shaped such that the medical instrument is only capable of incising the living tissue when the temperature of the heating unit is set to the temperature at which the living tissue is incised. Amended claim 49 is fully supported by the elected Species 42 (corresponding to the forty-second embodiment described in the specification and shown in Figs. 58-62).

Independent claim 52 has been amended: to clarify that the first engaging portion comprises a protrusion; to clarify that the heating unit is provided in the first engaging portion in contact with the protrusion and heats the protrusion when energized; and to clarify that the first engaging surface is shaped such that the coagulating/cutting instrument is capable of incising the living tissue held between the first and second engaging portions only when the protrusion is heated by the heating unit. Amended claim 52 is fully supported by the elected Species 42 (corresponding to the forty-second embodiment described in the specification and shown in Figs. 58-62).

Claims 53 and 54 have been amended to better accord with their amended parent claim 52.

Independent claim 61 has been amended: to clarify that a first holding portion of the pair of holding portions comprises a

heat generating portion which generates heat, and a protrusion which comprises the contact surface of the first holding portion and which is in contact with the heat generating portion to be heated by the heat generating portion; and to clarify that the contact surface of the first holding portion has a contact area with the living tissue that is smaller than a contact area with the living tissue of the contact surface of a second holding portion of the pair of holding portions that does not include the heat generating portion, and the protrusion is shaped such that the surgical instrument is capable of incising the living tissue only when the protrusion is heated by the heat generating portion. Amended claim 61 is fully supported by the elected Species 42 (corresponding to the forty-second embodiment described in the specification and shown in Figs. 58-62).

Claims 62, 63 and 65-69 have been amended to better accord with their amended parent claim 61.

No new matter has been added, and it is respectfully requested that the amendments to the claims be approved and entered.

#### THE PRIOR ART REJECTIONS

Claims 1, 49-56, 61-63, 65, 66 and 69 were rejected under 35 USC 102 as being anticipated by USP 6,626,901 (newly cited "Treat

et al").<sup>1</sup> In addition, claims 1, 52, 53 and 61 were rejected under 35 USC 103 as being obvious in view of the combination of USP 5,908,420 (previously cited "Parins et al") and Treat et al; claims 1 and 49-54 were rejected under 35 USC 103 as being obvious in view of the combination of USP 6,679,882 (previously cited "Kornerup") and Treat et al; claims 1, 49-56 and 61-69 were rejected under 35 USC 103 as being obvious in view of the combination of USP 6,273,887 (previously cited "Yamauchi et al") and Treat et al;<sup>2</sup> claims 1, 49-54 and 61-68 were rejected under 35 USC 103 as being obvious in view of the combination of USP 6,174,309 (previously cited "Wrublewski et al") and Treat et al; claims 61-65 and 67-69 were rejected under 35 USC 103 as being obvious in view of the combination of USP 6,113,598 (previously cited "Baker") and Treat et al; claims 55-60 and 69 were rejected under 35 USC 103 as being obvious in view of the combination of Wrublewski et al, Treat et al and Baker; claims 57-59 were rejected under 35 USC 103 as being obvious in view of the combination of Yamauchi et al, Treat et al and Baker; and

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<sup>1</sup> While the Examiner asserts that claims 55, 56 and 69 are anticipated by Treat et al on page 2 of the Office Action, the Examiner cites Baker with respect to these claims on page 9 of the Office Action.

<sup>2</sup> The rejection in view of Yamauchi et al set forth in the middle of page 4 of the Office Action does not mention Treat et al, which is nevertheless cited in the rejection at the bottom of page 4 of the Office Action.

claims 55-60 and 69 were rejected under 35 USC 103 as being obvious in view of the combination of Treat et al and Baker. These rejections, however, are all respectfully traversed with respect to the claims as amended hereinabove.

On page 2 of the Office Action, the Examiner does not indicate what portions of Treat et al are considered to correspond to each of the claims that the Examiner asserts are anticipated by Treat et al.

Nevertheless, it is noted that according to Treat et al, an instrument is provided to seal and/or cut tissue using a heating element provided on the instrument. More specifically, according one embodiment of Treat et al a forceps instrument is provided that includes arms having distal ends 224 and 226 in which one or both of the distal ends is provided with a heating wire 228. See Figs. 12-18 of Treat et al and the corresponding disclosure at column 15, line 32 to column 18, line 43. According to Treat et al, the resistance wire is heated and contacted to tissue so that the tissue directly contacting or immediately adjacent to the heated wire becomes very hot and is severed. In addition, according to Treat et al, tissue that is not contacted to or immediately adjacent to the heated wire is also heated, but not to a same degree, such that tissue adjacent to the severed portion is sealed.

Based on the Examiner's repeated references to column 17, lines 55+ of Treat et al in the various rejections under 35 USC 103, it is understood that the Examiner considers this embodiment of Figs. 12-18 of Treat et al to anticipate claims 1, 49-56, 61-63, 65, 66 and 69.

It is respectfully pointed out, however, that this embodiment of Treat et al relates to directly contacting a heated element to tissue to be severed (column 18, lines 16-18). By contrast, according to amended independent claim 1, a heat generating portion is provided at a first grasp member of the pair of grasp members, and generates heat in accordance with current supplied thereto, while a cutting member is disposed at the first grasp portion in contact with the heat generating portion. It is respectfully submitted that the invention of Treat et al clearly does not include both a heat generating portion at one of a pair of grasp members as well as a cutting member in contact with the heat generating portion as recited in amended independent claim 1.

Similarly, it is respectfully submitted that the invention of Treat et al does not include a first engaging portion comprising a protrusion as well as a heating unit provided in the first engaging portion in contact with the protrusion to heat the protrusion, as recited in amended independent claims 49 and 52.

And it is respectfully submitted that the invention of Treat et al does not include the structure recited in amended independent claim 61 whereby a first holding portion of a pair of holding portions comprises a heat generating portion which generates heat, and a protrusion which comprises the contact surface of the first holding portion and which is in contact with the heat generating portion to be heated by the heat generating portion.

The Examiner has also cited Treat et al in combination with various previously cited references which, as explained in the Amendment filed on September 29, 2006, all relate to supplying current to tissue to coagulate or cut tissue. Thus, the other cited references relate to structures in which current is supplied to tissue directly through portions of a medical instrument. And it is respectfully submitted that even if the combinations with Treat et al suggested by the Examiner were reasonable, these previously cited references and Treat et al would not achieve or render obvious the structure recited in amended independent claims 1, 49, 52 and 61 whereby both a heat generating portion or heating unit and a (projecting) cutting member or protrusion (having an engaging or contact surface) heated by the heat generating portion are provided at a grasp member or engaging portion or holding portion, and whereby: the

cutting member is shaped so as to be capable of cutting the patient's body tissue only when the heat generating portion is activated (claim 1); the first engaging surface is shaped such that the medical instrument is only capable of incising the living tissue when the temperature of the heating unit is set to the temperature at which the living tissue is incised (claim 49); the first engaging surface is shaped such that the coagulating/cutting instrument is capable of incising the living tissue held between the first and second engaging portions only when the protrusion is heated by the heating unit (claim 52); or contact surface of the first holding portion has a contact area with the living tissue that is smaller than a contact area with the living tissue of the contact surface of a second holding portion of the pair of holding portions that does not include the heat generating portion, and the protrusion is shaped such that the surgical instrument is capable of incising the living tissue only when the protrusion is heated by the heat generating portion (claim 61).

In view of the foregoing, it is respectfully submitted that the claimed present invention clearly patentably distinguishes over all of the prior art of record, taken singly or in any combination consistent with the respective fair teachings thereof, under 35 USC 102 as well as under 35 USC 103.



INFORMATION DISCLOSURE STATEMENT

Submitted herewith is an Information Disclosure Statement listing publications discussed in the Background section of USP 6,626,901 (Treat et al discussed above). The Examiner is respectfully referred to the bottom of column 3 and top of column 4 of Treat et al.

It is respectfully submitted that the independent claims as amended hereinabove all recite structural features that are not disclosed, taught or suggest by the publications listed in the IDS submitted herewith.

It is respectfully requested that an initialed copy of the form PTO/SB/08A be returned to confirm that the Examiner has considered the publications listed thereon and made them of record.

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In view of the foregoing, entry of this Amendment, allowance of the claims and the passing of this application to issue are respectfully solicited.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned for prompt action.

Respectfully submitted,

/Douglas Holtz/

Douglas Holtz  
Reg. No. 33,902

Frishauf, Holtz, Goodman & Chick, P.C.  
220 Fifth Avenue - 16<sup>th</sup> Floor  
New York, New York 10001-7708  
Tel. No. (212) 319-4900

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